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PATENT

Practitioner's Docket No. U 014742-0

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: J. R. PATIL ET AL.

Application No.: 10/629,309

Group No.: 1653

Filed: JULY 29, 2003

Examiner: ROSANNE KOSSON

For: BIOEMULSIFIER PRODUCTION BY ACINETOBACTER STRAINS ISOLATED FROM  
HEALTHY HUMAN SKIN

Mail Stop RCE  
 Commissioner for Patents  
 P. O. Box 1450  
 Alexandria, VA 22313-1450

REQUEST FOR CONTINUED EXAMINATION (RCE)  
(37 C.F.R. 1.114)

1. Applicant hereby requests continued examination, in accordance with 37 C.F.R. Section 1.114, for the above identified application.

## CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.10

(When using Express Mail, the Express Mail label number is mandatory;  
 Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. Section 1.8(a)

37 C.F.R. Section 1.10

with sufficient postage as first class mail.  as "Express Mail Post Office to Addressee" Mailing Label No. \_\_\_\_\_ (mandatory)

## TRANSMISSION

facsimile transmitted to the Patent and Trademark Office at (571)-273-8300

Date: July 26, 2006

Janet Cord

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

07/27/2006 TL0111 00000063 120425 10629389  
 02 FC:1254 1500.00 DA  
 07/27/2006 TL0111 00000063 120425 10629389  
 01 FC:1001 790.00 DA  
 07/27/2006 TL0111 00000063 120425 10629389  
 02 FC:1254 1500.00 DA

**NOTE:** 37 C.F.R. § 1.114 Request for continued examination:

"(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(c) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(c), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section."

**NOTE:** An applicant may file a submission under 37 C.F.R. 1.114 containing only an information disclosure statement (37 C.F.R. 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. § 151. An appeal brief or a reply brief (or related papers) will not be considered a submission under 37 C.F.R. 1.114. See 37 C.F.R. 1.114(d). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In addition, a previously filed amendment after final may satisfy this submission requirement. American Inventor's Protection Act of 1999, Question & Answer A5.

**NOTE:** Even though an RCE is improper (e.g., because it was filed before the prosecution is closed), an amendment submitted with the RCE will still be entered and considered by the examiner since it was timely filed and responsive to the non-final Office action in compliance with 37 C.F.R. 1.111. American Inventor's Protection Act of 1999, Question & Answer A4.

**WARNING:** 35 U.S.C. 132(b) and Section 1.114 provide for the continued examination of an application and not examination of a continuing application). Accordingly, the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined. Notice of March 10, 2000, 65 Fed Reg 14865, at 14868.

**WARNING:** The provisions of 37 C.F.R. 1.114 also do not apply (1) to a provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995 (4) a patent under reexamination or (5) an application for a design patent. 37 C.F.R. § 1.114(e).

**WARNING:** The PTO has pointed out why § 1.97(b) does not provide that an information disclosure statement will be considered if it is filed within three months after the date of a request for continued examination under § 1.114. The PTO explained that since an RCE filing is a reply under 35 U.S.C. 132, the applicant may be entitled to patent term adjustment if the Office does not act on an application containing a request for continued examination under § 1.114 within four months. See 35 U.S.C. 154(b)(1)(A)(ii). Thus, the Office cannot delay action on RCE applications for three months to determine whether an information disclosure statement will be filed. The Office, however, is adopting provisions (§ 1.103(e)) for a limited suspension of action after the filing of a request for continued examination under § 1.114, for the applicant to obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement for amendments, or an affidavit or declaration) after the filing of the RCE. See Notice of August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule", 65 Fed. Reg., pages 50091-50105, at page 50100 (comment 11); OGI: September 5, 2000, pages 13-24

**WARNING:** *One of the time periods excluded from patent term adjustment is the time consumed by a continued examination request under 35 U.S.C. 132(b) (§ 1.114(b)(1)).*

**WARNING:** *The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires an applicant to "prosecute the application" within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law (35 U.S.C. 133).*

*The Office will treat a request for continued examination under § 1.114 containing a bona fide submission that is not fully responsive to the prior Office action under the practice set forth in § 1.135(c). In addition, under the limited suspension of action provisions of § 1.103(c), an applicant must still file a request for continued examination practice in compliance with § 1.114, but may obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement, amendments, or an affidavit or declaration after the filing of the request for continued examination.*

*See Notice of August 16, 2000, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule", 63 Fed. Reg., pages 50091-50105, at page 50102 (comment 20); OG: September 5, 29000, pages 13-24, Page 50102.*

**WARNING:** *Section 197(b) does not provide that an information disclosure statement will be considered if it is filed within three months after the date of request for continued examination under § 1.114.*

**NOTE:** *There is no limit to the number of times the fee for continued examination may be submitted. Notice of March 10, 2000, 65 Fed. Reg. 14865, at 14868.*

**NOTE:** *Unlike a continuation application, a continued examination request can utilize the mailing procedure of 37 C.F.R. 1.8. See 37 C.F.R. Section 1.8(a)(2)(i)(A).*

## TIME REQUEST IS BEING MADE

2. This request is being submitted (*check appropriate item(s) below*):

- i.  Prior to abandonment of the application
- ii.  Payment of the issue fee
  - Prior to payment of issue fee
  - Issue fee has been paid but a petition under Section 1.313 has been granted

- iii.  Prior to a decision on appeal to the Board of Patent Appeals & Interferences
  - A notice is being separately sent to the Board of Patent Appeals & Interferences that this Request for Continued Examination is being filed.

**NOTE:** *If such a notice is not sent to the Board, they may refuse to vacate a decision rendered after the filing of the RCE but before recognition by the Office of the RCE request under Section 1.114.*

- iv.  Appeal to the U.S. Court of Appeals of the Federal Circuit under 35 U.S.C. 145 or Commencement of a civil action under 35 U.S.C. 146
  - Prior to the filing of such appeal or commencement of civil action
  - Such appeal or commencement of civil action has been terminated

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ENCLOSURES

JUL 26 2006

3. Do not automatically enter any prior unentered amendment(s) if herewith as the required submission is/are:

Request hereby to enter unentered amendment(s) of \_\_\_\_\_.

An information disclosure (37 C.F.R. Section 1.98)  
 Form PTO-1449 (PTO/SB/08A and 08B)

An amendment

New arguments

New evidence in support of patentability

**WARNING:** *If reply to a final or non-final Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of Section 1.111, 37 C.F.R. Section 1.114(b).*

Other:

#### FEE FOR REQUEST (37 C.F.R. Section 1.17(e)).

4. This application is on behalf of:

<input type="checkbox"/> Small entity (and status is still as small entity)	\$ 395.00
<input checked="" type="checkbox"/> Other than a small entity	\$ 790.00
Continued Prosecution Request Fee	
<u>\$ 790</u>	

#### FEE FOR CLAIMS

**NOTE:** "The fee for continued examination under Section 1.114 (Section 1.17(e)) does not include additional claim fees (cf. 1.53 (d)(3)(ii))." See Notice of March 10, 2000, 65 Fed Reg 14865, at 14868.

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5. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below:

(Col. 1) Claims Remaining After Amendment	(Col. 2) Highest No. Previously Paid For	(Col. 3) Present Extra	SMALL ENTITY Rate	OTHER THAN A SMALL ENTITY Addit. Fee OR Rate	OTHER THAN A SMALL ENTITY Addit. Fee
Total	*	Minus	**	--	x \$25 = \$
Indep.	*	Minus	***	=	x \$100 = \$
[ ] First Presentation of Multiple Dependent Claim				+ \$180 = \$	+ \$360 = \$
				Total Addit. Fee \$ _____	Total Addit. Fee \$ _____
				OR	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.  
 \*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: See 37 C.F.R. Section 1.116.

## EXTENSION OF TIME

(If an extension of time is appropriate complete (a) or (b), as applicable)

6. The proceedings herein are for a patent application, and the provisions of 37 C.F.R. Section 1.136(a) apply.

(a) [ X ] Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. Section 1.17(a)(1)-(4), for the total number of months checked below:

Extension for <u>months</u>	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
[ ] one month	\$ 120.00	\$ 60.00
[ ] two months	\$ 450.00	\$ 225.00
[ ] three months	\$ 1,020.00	\$ 510.00
[ X ] four months	\$ 1,590.00	\$ 795.00

Fee \$ 1590 \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

(Request for Continued Examination, if applicable)

An extension for \_\_\_\_\_ months has already been secured, and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

OR

(b)  Applicant believes that no extension of time is required. However, this is a conditional petition and authorization to pay the necessary fees to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

#### TOTAL FEE(S) DUE

*WARNING: The fee for continued examination under Section 1.114 may not be deferred 37 C.F.R. Section 1.53(j)*

7. The total fee(s) due is/are:

Continued Prosecution Fee (Section 1.17(e))	\$ 790
Fee(s) for additional claims (if any) (Section 1.16(b)-(d))	\$ _____
Extension of time fee (if any) (Section 1.17(a)(1)-(4))	\$ 1590
Total Fee(s) Due:	\$ 2380

#### PAYMENT OF FEE(S) DUE

8. Please pay the fee(s) for this continued examination application as follows:

<input type="checkbox"/> Check is attached for the sum of	\$ _____
<input checked="" type="checkbox"/> Charge Account <u>12-0425</u> the sum of	\$ 2380

Please charge any required additional fee(s) for Section 1.17(e), Section 1.16(b)-(d) and/or Section 1.17(a)(1)-(4) or refund overpayment to

Deposit Account 12-0425

## INVENTORSHIP

NOTE Any change of inventors must be via the procedure set forth in 37 C.F.R. Section 1.48. See Notice of March 10, 2000, 65 Fed Reg 14863, at 14868.

9. This application as amended names as inventors:

- the same inventors as previously designated for the claims.
- fewer than the inventors previously designated and a statement accompanies this request for the deletion of the name or names of the person or persons who are not inventors of the invention now being claimed.
- a person not named previously as an inventor and a petition under 37 C.F.R. Section 1.48 is/has separately:
  - being filed
  - been filed

## DEFERRAL OF EXAMINATION

10.  A Request for Suspension of examination accompanies this request for continued examination. (See, 9-68 or Petition for Suspension)

Reg. No.: 33,778

Tel. No.: (212) 708-1935


 SIGNATURE OF PRACTITIONER

 Janet Cord  
 (type or print name of practitioner)

P.O. Address

 c/o Ladas & Parry LLP  
 26 West 61<sup>st</sup> Street  
 New York, N.Y. 10023

Customer No.:



00140

PATENT TRADEMARK OFFICE

(Request for Continued Examination (RCE) document 7/26/2006 17:39:00)

PAGE 7/11 \* RCVD AT 7/26/2006 5:37:25 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-2/18 \* DNI:2738300 \* CSID:2122468959 \* DURATION (mm:ss):03:34